

Patent Docket: SHZ-106/1800/2
Application Serial No. 09/734,949

REMARKS

This amendment responds to the Office Action dated October 12, 2004. Claims 1-40 and 54-57 remain pending in this case; claims 41-53 and 58-60 have been cancelled without disclaimer of or prejudice to the subject matter contained therein due to an election made in response to a restriction requirement.

CLAIMS 1, 25, 28, 31, 34, 54-55 ARE DIRECTED TO STATUTORY SUBJECT MATTER IN ACCORDANCE WITH 35 U.S.C. § 101

The Examiner rejected claims 1, 25, 28, 31, 34 and 54-55 under 35 U.S.C. § 101 as being directed to non-statutory subject matter. In general, the Examiner contends that the claims at issue are not within the technological arts, because the steps of the claims can be performed manually using a pen and paper. The Applicant respectfully disagrees with the Examiner's characterization of the claims at issue.

Several of the claims at issue include the recitation "captured sample" or the like. A sample of an experiential environment, such as an audio environment, cannot be obtained or captured using a pen and paper. A pen and paper can only be used to create a derivative work – but not a sample of a work. A sample may be defined as "a portion, piece, or segment that is representative of a whole." Thus the claims at issue cannot read on a method using a pen and paper, and therefore, the claimed elements must encompass something more than a handwritten recording of a media using a pencil and paper. Therefore, the applicants respectfully submit that the claims at issue are directed to statutory subject matter, and therefore request reconsideration and withdrawal of the rejection of claims 1, 25, 28, 31, 34 and 54-55.

Patent Docket: SHZ-106/1800/2
Application Serial No. 09/734,949

**CLAIMS 1-8, 12, 15-21, 24-25, 28-37 AND 54-56 ARE PATENTABLE OVER
BOND**

The Examiner rejected claims 1-8, 12, 15-21, 24-25, 28-37 and 54-56 under 35 U.S.C. §102(c) [sic] as being anticipated by Paul Bond's article "A star is born nationally seeking stellar CD sales" [hereinafter "Bond"]. Essentially, the Examiner contends that Bond discloses all of the elements of the claims at issue. The Applicant respectfully disagrees with the Examiner's characterization of this reference vis-à-vis the claims at issue.

First, it should be noted that this rejection is based on 35 U.S.C. § 102(e), however, this paragraph requires the reference to be a U.S. Patent Application or a U.S. Patent. Yet Bond is neither a patent nor a patent application, and as such Bond is not a valid reference under 35 U.S.C. § 102(e). Therefore, this rejection cannot stand. Reconsideration and withdrawal of the rejection of these claims is respectfully requested.

Notwithstanding the above, Bond fails to anticipate the claims at issue. Claims 1-8, 12, 15-21, 24-25, 28-37 and 54-56 include *inter alia* "a sample of an experiential environment." According to these claims, this sample is captured or received or sent for processing. Bond simply fails to disclose this teaching – probably because Bond did not envision operating in accordance with the present invention. In contrast, the system described by Bond receives from the user an identification of the radio station playing a song from the user, which is then used to match a song played by the identified radio station as monitored by the StarCD computers. According to Bond, "[t]he service works like this: A listener hears a song on the radio she likes; she dials the StarCD phone number on her cell phone; and she uses the phone keypad to type in the station she's listening to." Thus, Bond envisioned some StarCD computer that monitored radio stations and identified the songs being played at certain times. This information is then used to identify the song desired by the user by employing the user-supplied identification of the radio station. However, in the StarCD system described by Bond no sample of the experiential environment is captured by the user and sent to the StarCD computer. In the system of the present invention, a sample is

Patent Docket: SIIZ-106/1800/2
Application Serial No. 09/734,949

captured by the user and the captured sample is then used for subsequent purposes. As such, the claims at issue are neither anticipated by nor made obvious by Bond.

CLAIMS 9-11, 13-14, 22-23 AND 30 ARE PATENTABLE OVER BOND AND ARENT

The Examiner rejected claims 9-11, 13-14, 22-23 and 30 under 35 U.S.C. § 103(a) as being unpatentable over Bond in view of U.S. Patent No. 6,018,824 to Arent [hereinafter "Arent"]. Essentially, the Examiner contends that Bond discloses all of the elements of the claims at issue, except for advertising or promotional offers. The Examiner then contends that Arent discloses this missing teaching. The Applicant respectfully disagrees with the Examiner's characterization of these references vis-à-vis the claims at issue.

As discussed above, Bond fails to disclose "a sample of an experiential environment." Moreover, Arent also fails to disclose this teaching. As a result, any combination of Bond and Arent also fails to disclose this teaching.

In short, the Applicant respectfully submits that the Examiner has failed to make a *prima facie* case for obviousness because the combination of these references (*i.e.*, Bond and Arent), even assuming *arguendo* they can be combined, does not disclose or suggest all elements of Applicant's rejected claims. As such, the claims at issue are neither anticipated by nor made obvious by these references (*i.e.*, Bond and Arent), either taken alone or in any combination.

CONCLUSION

The Applicants respectfully submit this application is in condition for allowance and request issuance of a Notice of Allowance.

In the event the prosecution of this application can be efficiently advanced by a phone discussion, it is requested that the undersigned attorney be called at (703) 435-9390.

Patent Docket: SHZ-106/1800/2
Application Serial No. 09/734,949

FEES

If additional amounts are due following the amendments made to the claims above, or for any other reason, it is respectfully requested that the PTO charge any deficiency or credit any overpayment to the deposit account of Mayer Fortkort & Williams PC, Deposit Account, #50-1047.

Respectfully submitted,

By 
Michael P. Fortkort Reg. No. 35,141

Date: January 11, 2005

Mayer, Fortkort & Williams, PC
251 North Avenue West, 2nd Floor
Westfield, New Jersey 07090


Please direct telephone calls to:
Michael P. Fortkort
703-435-9390 (direct)
703-435-8857 (facsimile)

Certificate of Facsimile Transmission

I hereby certify that this correspondence and any document referenced herein is being sent to the United States Patent and Trademark office via Facsimile to: 703-872-9326 on January 11, 2005.

MICHAEL P. FORTKORT
Marjorie Searini

(Printed Name of Person Sending Correspondence)


(Signature)